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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/031,268 | 03/23/2002 | Charles Eldering | T708-13 | 4098 |
| 27832 | 7590 | 10/10/2006 | | |
| TECHNOLOGY, PATENTS AND LICENSING, INC./PRIME 2003 SOUTH EASTON RD SUITE 208 DOYLESTOWN, PA 18901 | | | | |
| | | | EXAMINER BROWN, RUEBEN M | |
| | | | ART UNIT 2623 | PAPER NUMBER |

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,268

Applicant(s)

ELDERING, ET AL

Examiner

Reuben M. Brown

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2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/6/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52, 56, 57, 100-111, 126-140 and 146-197 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52, 56-57, 100-111, 126-140 & 146-197 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

With respect to Bryant, applicant's main argument is that the reference discloses that the advertisement data may be mixed with the video signal during distribution, as opposed to 'prior to transmission' as presently recited. Examiner agrees that Bryant does teach the cited embodiment. However, examiner points out that Bryant is not limited to that embodiment, but throughout the disclosure teaches that the advertisement and video signals may be mixed at the head-end, which reads on the claimed feature, see col. 3, lines 25-35; col. 4, lines 33-36 & col. 8, lines 55-56.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-52, 56-57, 100-11, 126-140 & 146-197 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant, (U.S. Pat # 5,652,615), in view of Hendricks, (U.S. Pat # 6,463,585).

Considering claim 1, the amended claimed 'advertising management system for managing insertion of advertisements in program streams, comprising an avail opportunities module for recognizing one or more opportunities within the video streams available for advertisements' reads on Bryant (col. 3, lines 26-40; col. 4, lines 21-64). Bryant discusses that the studio 110 composites broadcasts programs, which includes the main programs and advertisements, inserted commercials in the avail that is appropriate according to the desired geographic area and/ demographic make-up of the area or subscriber(s).

'creating an avail characteristic for each avail', is suggested in Bryant, which shows the composition of the broadcast signal, including the 'base' section, i.e. main program and 'filler' section, i.e. advertisements, col. 3, lines 25-36; col. 4, lines 37-48 & Fig. 3, and that the advertisements are transmitted to viewers based the content. Nevertheless, a more direct disclosure is found in Hendricks, col. 67, lines 45-67, which discloses an Advertisement Library 322 that includes an Advertisement Category Files, that organizes the advertisements according to category. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Bryant organize advertisements according to categories, as taught

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by Hendricks, at least for the advantage of more efficiently tracking the various advertisement available for the customers.

The claimed 'ad characterization module that creates ad characterization for the advertisements' is thus met by the Advertisement Category File 322, in Hendricks.

Thus the amended claimed 'correlation module for matching at least one of the advertisements to each of the one or more avails prior to transmitting the program streams to subscribers, such that the matching is based at least partially on correlation of the avail characterizations and the ad characterizations' reads on the disclosures of Bryant, col. 2, lines 32-36; col. 4, lines 10-20 & col. 7, lines 60-68 and Hendricks, col. 69, lines 61-67 through col. 70, lines 1-30.

The claimed 'ad insertion module for inserting the matched advertisements into program streams, wherein the bandwidths of the advertisement and the program streams are synchronized during the insertion ', reads on the combination of Bryant (col. 6, lines 30-55) & Hendricks (col. 70, lines 1-15).

Considering claim 2, Fig. 8 of Bryant is an example of the system listing the avail opportunities such as A, B, C, & D; col. 8, lines 35-49..

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Considering claim 3, the subject matter is met by Bryant, col. 3., lines 1-40.

Considering claims 4-13, 18-26, see Hendricks, col. 19, lines 49-62 & col. 21, lines 29-67.

Considering claims 14-15, the percentile of potential subscribers to transmit a particular commercial is deterministic range, based on the instant subscribers having a higher probability of purchasing the advertised item, (col. 6, lines 9-21).

Considering claims 16-17, see Bryant col. 4, lines 28-35 & Hendricks, col. 26, lines 54-67.

Considering claim 27, see Hendricks, col. 39.

Considering claim 28, the claimed impact value is met by Hendricks; col. 37, lines 30-67.

Considering claims 29 & 147, Hendricks discloses the use of the Privacy Act, in collecting profile data, col. 44, lines 59-65.

Considering claims 30-37, see Hendricks col. 20, lines 32-68 & col. 21, lines 34-67.

Considering claims 38-39, the subject matter is inherently found in Bryant.

Considering claim 40, regarding the claimed 'apparatus for inserting advertisements in a video stream, comprising an ad manager for receiving one or more advertisements from one or more sources and managing the ad insertion process', the claimed elements correspond with subject matter mentioned above in the rejection of claim 1, and is likewise treated.

Considering claims 41-43, Bryant teaches that the advertisements may be located at various different locations in the network, see col. 4, lines 21-38.

Considering claims 44-45, see Bryant col. 5 & col. 8, lines 35-55.

Considering claim 46, Bryant teaches that the system may operate in analog form, col. 8, lines 20-26.

Considering claims 47-52, 100-105 & 170-176, see Bryant (col. 4, lines 20-58; col. 6, lines 30-55); and Hendricks, (col. 21, lines 19-28; col. 55, lines 25-65; col. 62, lines 40-58).

Considering claims 106 & 177, the claimed pleisochronous manner reads on Hendricks, col. 61, lines 35-55.

Considering claims 107-111 & 178-11967, see Bryant col. 4, lines 48-65; col. 5, lines 1-40; col. 6, lines 30-55 and Hendricks, (col. 26, lines 54-67; col. 27, lines 40-65; col. 28, lines 30; col. 30, lines 10-64).

Considering claim 126 & 146, the claimed method of targeting advertisements to subscribers corresponds with subject matter mentioned above in the analysis of claims 1 & 40. As for the additional feature of characteristics defining target markets, see Bryant, col. 4, lines 18-35 & col. 8, lines 49-60.

Considering claims 127-134, see Bryant, Fig. 3; col. 5, lines 1-21; col. 6, lines 30-55.

Considering claims 134-140, see Hendricks, col. 66, lines 28-65; col. 69, lines 61-67 thru col. 70, lines 1-10.

Considering claims 148-158 & 166-169, see Hendricks, col. 66, lines 25-67; col. 67, lines 1-25.

Considering claims 159-165, see Hendricks, col. 20, lines 35-67; col. 21, lines 29-65; col. 42, lines 29-60.

Considering claims 196-197, see Hendricks, col. 54, lines 41-65.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Wachob Teaches transmitting commercial to viewers based on demographics.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:


(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown


HAITRAN
PRIMARY EXAMINER